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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,737	07/28/2003	**Masaki Okada**	03500.012432.1	3838

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EXAMINER	
HO, TUAN V	

ART UNIT	PAPER NUMBER
2622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/627,737	OKADA, MASAKI	
	Examiner	Art Unit	
	Tuan V. Ho	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. Applicant's arguments filed 10/21/08 have been fully considered but they are not persuasive.

With regard to claims 18, 21, 24 and 28, Applicant argues:

1)"By this arrangement, information discriminating the image file that has previously undergone transfer thereof from the memory to a different storing area and the image file that has not yet undergone the transfer thereof may be stored separately from the image file.", page 8 of the remarks. In response to the arguments, the examiner notes that Moronaga et al discloses in cols. 10 and 11 and indications 12A and 12B, the information discriminating the image file to different storage area and the image file has not yet undergone the transfer.

2)"this citation is not understood to disclose or suggest a memory control device which controls recording to record on a memory an image file corresponding to an image picked up by the image pickup device, and data which discriminates the image file that has previously undergone transfer thereof from the memory to a different storing area and the image file that has not yet undergone the transfer thereof, as also recited by amended Claim 18.", page 9 of the specification. In response to the arguments, the examiner notes that Moronaga et al discloses in cols. 10 and 11 and indications 12A and 12B, which shows the different storage and the image file.

With regard to double patenting rejections of claims 18-30, it should be noted that claim numbers 27-29 and 36-48 cited in paragraph 3 of the last Office action are typographical errors. The claim numbers should be claims 18-30 of the present application. Applicant argues:
1)"these claims are not directed to storing separately from an image file, information discriminating the image file that has previously undergone transfer thereof from the memory to

a different storing area and the image file that has not yet undergone the transfer thereof may be stored separately from the image file. For this reason, these claims recite that data indicating whether an image file has been previously transferred is attached to the image file. In contrast, independent Claims 18, 21, 24, and 28 recite no such limitation.", page 10 of the remarks. In response to the arguments, the examiner notes that claim 43 of Patent'954 discloses the claimed features in memory device paragraph.

2)"Since amended Claim 18 recites at least one feature not disclosed or suggested by Claims 27- 29 and 36-48 of the Okada patent, the Office is not understood to have yet satisfied its burden of proof to establish a prima facie case of obviousness-type double patenting against amended Claim 18. Therefore, Applicant respectfully requests that this rejection of amended Claim 18 over this citation be withdrawn.", page 10 of the remarks. In response to the arguments, the examiner notes that claim 18 is obvious variant and encompassed by claim 43 of Patent'954; where claimed elements are met by claim 43 of Patent'945.

For the above reasons, the rejections are repeated.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g.,

In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, ii F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 18-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 27-29 and 36-48 of U.S. Patent No. 6,630,954. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 18-20 are obvious variants and encompassed by claims 36-38 and 43-45 of Patent'954.

Claims 24-26 are obvious variants and encompassed by claims 36-38 and 43-45 of Patent'954.

Claim 27 is an obvious variant and encompassed by claim 39 of Patent'954.

Claims 21-23 are obvious variants and encompassed by claims 27-29, 40-42 and 46-48 of Patent'954.

Claims 28-30 are obvious variants and encompassed by claims 27-29, 40-42 and 46-48 of Patent'954.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Moronaga et al cited by Applicant (US 5,473,370).

With regard to claim 18, Moronaga et al discloses in Figs. i-3c, an electronic video camera that comprises the electronic apparatus (video camera i0, col. 9, line 20) for use with an image pickup device (CCD 38, col. 9, line 64), comprising a memory control device (CPU 44 and memory cartridge 29 or memory 28, col. 9,1ine 41), and data which indicates that the image file has previously undergone transfer thereof from the memory to a different storing area (indications 12A and 12B show CA 12 and IN 12, col. i0, lines 34-65 and col. ii, lines 1-35) or that the image file has not yet undergone the transfer thereof (indication 12A and 12B); and a control device that controls transfer of the image file from the memory to a different storing area

and rewrites the data in accordance with the transfer of the image file (CPU 44, col. ii, lines 18-23).

With regard to claim 19, Moronaga et al discloses in Figs. i-3c, an electronic video camera that comprises the notification means for notifying a user whether or not the image file stored in the memory previously has been transferred from the memory to the different storing area an accordance with the data attached to the image file (notifications CA 12 or IN 12, col. i0, lines 45-55).

With regard to claim 20, Moronaga et al discloses in Figs. i-3c, an electronic video camera that comprises the different storing area is in an external storage apparatus (cartridge 29 includes RAM 31).

With regard to claims 21-23, method claims 21-23 correspond to apparatus claims 18-20 and are analyzed the same as previously discussed with respect to apparatus claims 1-20.

With regard to claim 24, Moronaga et al discloses in Figs. i-3c, an electronic video camera including image files stored in memory cartridge 29 that comprises the memory device that controls a memory control device (CPU 44 and memories 28 and 29), and data which indicates that the image file has previously undergone transfer thereof from the memory to a different storing area (CA 12 and IN 12) or that the image file has not yet undergone the transfer thereof (CA 12 and IN 12); and a memory to a different storing area and rewrites the data in accordance with the transfer of the image file (CPU 44).

Claims 25 and 26 recite what was discussed with respect to claims 19 and 20.

With regard to claims 28-30, method claims 28-30 correspond to apparatus claims 24-26 and are analyzed the same as previously discussed with respect to apparatus claims 24-26.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan Ho whose telephone number is (571) 272-7365. The examiner can normally be reached on Mon-Fri 7:00AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access

to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tuan V Ho/

Primary Examiner, Art Unit 2622